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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,024

04/01/2005

Mathias Bergman

014975-113

2906

21839 7590 08/29/2007
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

LUKTON, DAVID

ART UNIT

PAPER NUMBER

1654

MAIL DATE

DELIVERY MODE

08/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,024	Applicant(s) BERGMAN ET AL.	
	Examiner David Lukton	Art Unit 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

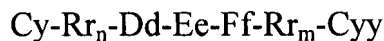
- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Pursuant to preliminary amendment, several claims have been amended, and claims 28-30 added. Claims 1-30 are now pending.

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Restriction to one of the following inventions is required under 35 U.S.C. §121:

1) Claims 1-12, 21, drawn to a compound that comprises the following formula:



2) Claim 13, drawn to a compound that is obtained by derivatizing or activating or protecting a compound of the following formula:



or the compound of the indicated formula which is bonded to a solid support.

3) Claims 14-20, 28, drawn to a conjugate of an "effector unit" and a compound of the following formula: $\text{Cy-Rr}_n\text{-Dd-Ee-Ff-Rr}_m\text{-Cyy}$

4) Claims 22-24, drawn to a method of preparing a medicament.

5) Claims 25-27, drawn to a method of treating cancer by administering one of the Group 1 compounds/compositions.

6) Claim 29, drawn to a method of preparing a medicament.

7) Claim 30, drawn to a method for treating cancer.

The claimed inventions are distinct.

Inventions 1 and {4, 5} are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). However, in the event that Group 1 is elected, and claims therein found allowable, the corresponding method-of-use claims will be rejoined for further examination provided that the limitations present in the claims (drawn to the composition) are incorporated into the method claims [*In re Ochiai* (37 USPQ2d 1127)].

In addition, in the event that Group 1 is elected, and claims therein found allowable, the restriction between Groups 1 and 3 will have to be revisited. It is more likely than not that novelty would accrue to the Group 3 claims in such a circumstance.

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

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In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect disclosed species (as follows) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

In the event that Group I is chosen for initial examination, election is required of each of the following:

- a) one of the following: (i) a compound *per se* (in accordance with claim 1) or (ii) a composition (in accordance with claim 21);
- b) in the event that a compound is elected, election is required of a specific and fully defined compound (which can be described without the use of the term "comprising" or "consisting essentially of");
- c) in the event that a composition is elected (in accordance with claim 19), election is required of a specific and fully defined composition in which all ingredients are fully accounted for.

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In the event that Group 2 is chosen for initial examination, election is required of a specific and fully defined compound.

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In the event that Group 3 is chosen for initial examination, election is required of each of the following:

- a) one of the following: (i) a compound *per se* (in accordance with claim 11) or (ii) a composition (in accordance with claim 28);
- b) in the event that a compound is elected, election is required of a specific and fully defined compound (which can be described without the use of the term "comprising" or "consisting essentially of");

c) in the event that a composition is elected (in accordance with claim 28), election is required of a specific and fully defined composition in which all ingredients are fully accounted for.

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In the event that Group 4 is chosen for initial examination, election is required of each of the following:

a) one of the following: (i) the target medicament is a compound *per se* or (ii) the target medicament is a composition;

b) in the event that the target medicament is a compound *per se*, election is required of a specific and fully defined compound;

c) in the event that the target medicament is a composition, election is required of a specific and fully defined composition.

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In the event that Group 6 is chosen for initial examination, election is required of each of the following:

a) one of the following: (i) the target medicament is a compound *per se* or (ii) the target medicament is a composition;

b) in the event that the target medicament is a compound *per se*, election is required of a specific and fully defined compound;

c) in the event that the target medicament is a composition, election is required of a specific and fully defined composition;

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



DAVID LUKTON, PH.D.
PRIMARY EXAMINER